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UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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In re Application of
Gek-Kee Sim et al.
Application No.: 09/646,561
PCT No.: PCT/US99/06187
Int. Filing Date: 19 March 1999
Priority Date: 19 March 1998
Attorney's Docket No.: HKZ-029CPUS
For: T CELL COSTIMULATORY PROTEINS,
SEQUENCES AND USES THEREOF

:
:
: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.47(a)
:

This is a decision in response to the declaration and renewed petition filed under 37 CFR 1.47(a) on 17 September 2001, to accept the application without the signature of co-inventor Gee-Kee Sim. The required \$130 petition fee has been received.

BACKGROUND

On 19 March 1999, applicants filed international application PCT/US99/06187, which claimed priority of an earlier US application filed 17 April 1998 and an earlier provisional application filed 19 March 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from applicant on 19 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 October 1999. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 19 September 2000.

On 19 September 2000, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c).

On 01 November 2000, the United States Designated/Elected Office mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/EO/EO905), indicating that an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) needed to be filed. The notification set a one month time period in which to respond.

On 01 February 2001, applicant filed a response to the PCT/DO/EO/905 including a petition under 37 CFR 1.47 (a) and the required petition fee, and the required surcharge for filing the declaration later than 30 months from the earliest priority date.

A decision of the petition was mailed to applicant on 17 May 2001 indicating that before a refusal to sign a declaration can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application.

On 17 September 2001, applicant filed the current Renewed Petition under 37 CFR 1.47(a) and a \$130 fee; the declaration of Timothy McCutcheon including various exhibits; the unexecuted declaration, petition and power of attorney; a request for a two-month extension of time and the required fee; and, a petition to revive and the appropriate fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

With respect to item (1), the \$130 petition fee under 37 CFR 1.17(h) was included with the original petition. Therefore, no additional fee is due. The enclosed \$130 fee will be refunded to applicant's deposit account.

With respect to item (2), Mr. Timothy McCutcheon states that he left various email and voice messages on Dr. Sim's telephone. Dr. Sim did not respond to any of the messages. Further, on 26 July 2001, Mr. McCutcheon sent Dr. Sim, by Federal Express, a spiral bound copy of the application as well as the assignment and declaration. On 27 July 2001, G. Sim signed for this package as evidenced by the "Track Response."

With respect to item (3), Dr. Sim's last known address is furnished in Mr. McCutcheon's declaration.

Regarding item (4), applicants included a Declaration signed by two of the three co-inventors with the original petition. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has been satisfied.

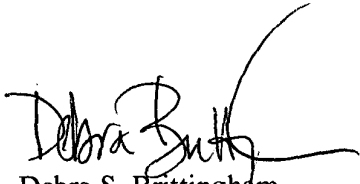
With respect to applicant's petition to revive, no such petition is necessary. Therefore, the fee of \$620 will be refunded to applicant's deposit account.

CONCLUSION

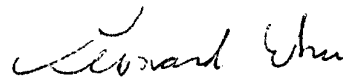
The petition under 37 CFR 1.47(a) is GRANTED.

Applicant's **DEPOSIT ACCOUNT 12-0080** will be **refunded \$750**.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision; and, if appropriate, a Notification of Acceptance of Application (Form PCT/DO/EO/903) will be mailed showing a 35 U.S.C. 371 date of 01 February 2001.



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Dear Dr. Sim:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

A handwritten signature in black ink, appearing to read "Debra S. Brittingham".

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